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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,445	11/21/2000	Leo J. Romanczyk JR.	5677-142	1983

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EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,445

Applicant(s)

Romanczyk JR, et al.

Examiner

Christopher Tate

Art Unit

1654



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 11, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44, 46-55, and 59 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44, 46-55, and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

The amendment filed February 11, 2003 is acknowledged and has been entered. Claims 44, 46-55, and 59 have been examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

Although Applicants stated in the February 11, 2003 response that a substitute specification was filed therewith, no such specification was received with the response.

Thus, as set forth in the previous Office action, it remains noted that the instant disclosure differs from that of the divisional parent and grandparent applications (Application Nos. 09/172,873, 08/839,446, 08/687,885, and 08/317,226) - i.e, pages 47-52 are missing from the instant specification (although Applicants state in Paper No. 4 that pages 47-54 are missing therefrom). Please note that the addition and/or deletion of recitations from a continuation (divisional) application is impermissible as both constitute new matter. New matter (including deletions) is only permitted to be introduced in a continuation-in-part (CIP) application. Accordingly, the specification is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no new matter shall be introduced into the disclosure of the invention.

Because of the differences between the instant specification and the parent applications, a substitute specification (which reintroduces the missing text of original pages 47-52) is requested.

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A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the parent specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Claim Rejections - 35 U.S.C. § 112

Claims 44, 46-55, and 59 are/stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 44 is rendered vague and indefinite because it is unclear if the food or the food additive comprises the recited mixture of cocoa polyphenols.

Claim 46 is rendered vague and indefinite because it depends from a canceled claim (claim 45).

Claim 48 remains vague and indefinite because it is unclear by the phrase "wherein certain cocoa procyanidin fractions are selected and pooled" as to which fractions are from those defined in claim 47 are actually selected and pooled - i.e., the metes and bounds are not clearly delineated with respect to which fractions are actually selected and pooled.

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All other claims depend directly or indirectly from rejected claims and are, therefore, also rejected under U.S.C. 112, second paragraph for the reasons set forth above.

Double Patenting

Claims 44, 46-55, and 59 are/stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 13 of U.S. Patent No. 5,554,645, for the reasons set forth in the previous Office action.

Claims 44 and 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,399,139 for the reasons set forth in the previous Office action.

Claims 44, 46-55, and 59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/768,473 for the reasons set forth in the previous Office action.

Applicants' arguments with respect to the obviousness-type double patenting (ODP) rejections have been carefully considered but are not deemed to be persuasive of error in the rejections. Applicants argue that the '645 claims are directed to a preservative composition which consists essentially of polyphenols of oligomers 3-12, whereas the instant claims are

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drawn to a food comprising such polyphenols. However, as discussed in the previous Office action, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add the claimed cocoa extract preservative of US '645 to a foodstuff so as to beneficially preserve the foodstuff, especially since the addition of preservatives to foodstuff for such beneficial purpose is notoriously well known and accepted in the art to advantageously prolong its freshness and/or storage by inhibiting spoilage thereof. Further, the phrase "consisting essentially of" reads upon "comprising" especially with respect to a food comprising (consisting essentially of) the claimed bioactive cocoa extract. Applicants further argue that, among other differences, the '139 claims are drawn to an improved food product comprising cocoa polyphenols as well as other ingredients therein. However, the broad instant claims 44 and 46 stand rejected under ODP for the reasons set forth in the previous Office action. Applicants also argue that the claims in provisional application '753 contain no food claims. However, as is the case with the '454 claims, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add the claimed cocoa extract preservative of US '645 to a foodstuff so as to beneficially preserve the foodstuff, especially since the addition of preservatives to foodstuff for such beneficial purpose is notoriously well known and accepted in the art to advantageously prolong its freshness and/or storage by inhibiting spoilage thereof.

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Claim Rejections - 35 U.S.C. § 102

Claims 44 and 46 stand rejected under 35 U.S.C. 102(b) as being anticipated by Zieglader et al. (CCB Rev., 1983), Omori (JP 08205818 - JPAB Abstract), Maruyama et al. (JP 04077424), Kattenberg (US 4,704,292), Helmona AG (FR 2307779 - DWPI Abstract + French patent), Osakabe et al. (JP 7-274894 - English translation), or Osakabe et al. (JP 7-213251 - English translation), with evidence provided by Hammerstone et al. (J. Agricult. Food Chem., 1999 - please note that Hammerstone et al. is not being cited as prior art, but instead as evidence to show that various prior art cocoa extracts inherently contain polyphenols such as claimed) for the reasons set forth in the previous Office action.

Claim Rejections - 35 U.S.C. § 103

Claims 44 and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zielader et al. (CCB Rev., 1983), Omori (JP 08205818 - JPAB Abstract), Maruyama et al. (JP 04077424), Kattenberg (US 4,704,292), Helmona AG (FR 2307779 - DWPI Abstract + French patent), Osakabe et al. (JP 7-274894 - English translation), Osakabe et al. (JP 7-213251 - English translation), and Kashket (US 4,906,480), and (if necessary) in view of Clappertone et al. (XVI Intl. Conf. of Groupe Polyphenols, 1992), with evidence provided by Hammerstone et al. (J. Agricult. Food Chem., 1999 - again, please note that Hammerstone et al. is not being cited as prior art, but instead as evidence to show that various prior art cocoa extracts inherently contain polyphenols such as claimed) for the reasons set forth in the previous Office action.

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Applicants' arguments with respect to the art rejections above (over the broad instant claims 44 and 46) have been carefully considered but are not deemed to be persuasive of error in the rejections. Applicants argue that the Hammerstone et al. reference is not just being relied upon to show the cocoa extracts of the cited prior art references comprise naturally occurring polyphenols such as those claimed, but also as a prior art reference. However, as discussed and clearly pointed out in the previous Office action, the Hammerstone et al. reference was indeed cited only as evidence to show the inherent properties of the cocoa extracts of the cited prior art and not as a prior art reference. In addition, Applicants have argued and discussed references individually without clearly addressing the combined teachings. It must be remembered that the references are relied upon in combination and are not meant to be considered separately as in a vacuum. It is the combination of all of the cited and relied upon references which make up the state of the art with regard to the claimed invention. Applicant's claimed invention fails to patentably distinguish over the state of the art represented by the references.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Conclusion

No claim is allowed. However, provided the above obviousness-type double patenting rejections are fully and properly overcome (via a Terminal Disclaimer) as well as the U.S.C. 112, second paragraph rejections above, claims 47-55 and 59 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (703) 305-7114. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached at (703) 306-3220. The Group receptionist may be reached at (703) 308-0196. The fax number for art unit 1654 is (703) 872-9306.



Christopher R. Tate
Primary Examiner, Group 1654